REMARKS

Response to Restriction

The Office requires restriction of the invention to one of the following groups:

Group I, claims 1-9 and 21-23, drawn to a production process for a transesterified oil/fat or triglyceride, by transesterification of 50-100 parts by weight of one or more fungus-produced oils/fats or triglycerides containing at least 20% or more carbons and two or more double bonds and 0-50 parts by weight of one or more vegetable oils/fats or triglycerides, using a 1,3-position specific type lipase; or

Group II, claims 10-16 and 22, drawn to a transesterified oil/fat or triglyceride product which is obtained by a process for a transesterified oil/fat or triglyceride, by transesterification of 50-100 parts by weight of one or more fungus-produced oils/fats or triglycerides containing at least 20% of polyunsaturated fatty acids containing 20 or more carbons and two or more double bonds and 0-50 parts by weight of one or more vegetable oils/fats or triglycerides, using a 1,-3-position specific type lipase; or

Group III, claim 17, drawn to a second product which is a transesterified oil/fat or triglyceride containing at least 20% of poly unsaturated fatty acids containing 20 or more carbons and two or more double bonds, and which contains at least 40% of triglycerides with one residue of poly unsaturated fatty acids containing 20 or more carbons and two or more double bonds in the molecule and/or no more than 4.0% of triqlycerides with 3 residues of the same ply unsaturated fatty acids containing 20 or more carbons and two or more double bonds; or

Group IV, claim 18, drawn to a third product which is an oil/fat or triglyceride containing at least 20% of arachidonic acid, and which contains at least 40% of triglycerides with one residue of arachidonic acid in the molecule and/or no more than 4.0% of AAA; or

Group V, claim 19, drawn to a fourth product which is an oil/fat or triglyceride containing at least 20% of dihomo-γ-linolenic acid, and which contains at least 40% of triglycerides with one residue of dihomo-γ-linolenic acid in the molecule and/or no more than 4.0% of DDD; or

Group VI, claim 20, drawn to a fifth product which is an oil/fat or triglyceride containing at least 20% of mead acid, and which contains at least 40% of triglycerides with one residue of mead acid in the molecule and/or no more than 4.0% of MMM; or

Group VII, claims 25-26, drawn to a sixth product which is a transesterified oil/fat or triglyceride containing at least 1 wt % of each of a triglyceride containing arachidonic acid (A) and medium-chain fatty acid (Z) as constituent fatty acid, ZAZ, wherein ZAZ is a triglyceride with 2 residues of medium-chain fatty acid and one residue of arachidonic acid, wherein arachidonic acid is bound to the position 2, and ZZA, wherein ZZA is a triglyceride with 2 residues of medium-chain fatty acid and one residue of arachidonic acid, wherein arachidonic acid is bound to the position 1 or 3; or

Group VIII, claim 27, drawn to a human nutritive comprising the product of Invention II; or

Group IX, claims 28-29, drawn to a food comprising the product of Invention II; or

Group X, claim 30, drawn to an animal feed comprising the product of Invention II.

Applicants elect **Group II, claims 10-16, *with traverse***.

Species Election

Applicants were also required to elect from the following species:

A. Whereby the product produced is:
(a) 20% of polyunsaturated fatty acids containing 20 or more carbons and two or more double bonds with a specific generic structure:
Ai arachidonic acid
Aii dihomo-gamma-linolenic acid
Aiii mead acid
(b) omega 6 series PUFA
Bi specify a structure
(c) omega 9 series PUFA
Ci specify a structure

B. Whereby the second vegetable oils/fats or triglycerides is:
(a) specify a structure

C. Whereby the transesterification uses 1,3-position specific type lipase produced by:
(a)i *Rhizopus delemar*
(a)ii *Rhizopus niveus*
(a)iii *Thizomucor miehei*
(a)iv *Rhizopus oryze.*

Applicants elect the following species ***with traverse***. For part A (product produced), Applicants elect (a) arachidonic acid), (b) omega 6 series PUFA: arachidonic acid, and (c) omega 9 series PUFA: MEAD acid) with traverse. For part B, Applicants elect palm oil with traverse. And for part C, Applicants elect the 1,3 position specific lipase produced by *Rhisopus Delmar.* Claims that read on the elected species are **claims 10-14**.

Applicants traverse the restriction for the following reasons: (1) an improper species election is required that does not comport with PCT practice guidelines, (2) unity of invention was found during examination of the parent PCT application, and (3) dependent claims are improperly divided from independent claims. For these reasons, the restriction should be reconsidered and withdrawn for the reasons set forth more fully below.

(1) Improper Species Election. This application is a national stage application, so any species election must be governed by relevant PCT procedures. Applicants direct the Office to the decision in *Caterpillar Tractor Co. v. Comm'r of Patents and Trademarks,* 231 U.S.P.Q. 590 (E.D. Va. 1986). In *Caterpillar Tractor*, the Court held that the treaty provisions under the Patent Cooperation Treaty trump those of the U.S. Patent and Trademark Office under a conflict of laws analysis. Under Article 27 of the PCT, "No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and Regulations." *Caterpillar Tractor,* 231 U.S.P.Q. at 590-591. The relevant PCT procedures are set forth at MPEP, "Administrative Instructions Under the PCT," Annex B(f).

Instead of applying PCT procedures, the Office institutes its own arbitrary species election without guidelines or stated authority. The Office is instituting a requirement different from and in addition to the requirements set forth by the PCT. It is therefore not permitted.

Further, the Office provides no reason why the search for the various species would be burdensome. The search of the claimed invention, including all the recited species, was ***already conducted*** in the corresponding International Application, and the Office provides no reason or

evidence why an additional search of the same art is burdensome. *See infra*. Further, the Office provides no reason why the search of all the species would require examination of more than a single class and subclass. For all these reasons, Applicants request withdrawal of the species election with the Office's next communication.

(2) Unity of Invention. When unity is found in the PCT application, there is an ***increased burden*** above the already "***serious burden***" in evincing why a restriction requirement is necessary. *See* Anthony Caputa, "Two Be or Not To Be: or Divide and Conquer: or A Case Divided Cannot Stand: Principles in Restriction Practice TC 1600," presented August 2004 to the Customer Partnership Meeting. As stated by Examiner Caputa, "If the inventions, now being restricted, were searched and examined together in either the current application or a parent, it will be difficult to justify the assertion of burden." T. Caputa, at page 6. *See also* MPEP §§ 803.02, 806.04(a), 806.04(i), 808.01(a) and 808.02.

The Searching Authority already has done the PTO's work. The Office does not explain why it has an ***increased*** burden of search under the circumstances. The Office mentions the burden of search, but does not even address its increased burden of search. Therefore, the restriction requirement is improper. The restriction should be duly reconsidered and withdrawn.

(3) Restriction Between Dependent and Independent Claims. Unity of invention has to be considered in the first place only in relation to the independent claims. MPEP, "Administrative Instructions Under the PCT," Annex B(c). Further, claims are not directed to distinct inventions, where the claimed subject matter overlaps in scope. *See* MPEP § 806.03. This is certainly the case when the claims within two allegedly distinct groups are related as independent and dependent claims. For this reason, claim 1 and claims depending therefrom must be rejoined and examined with the elected claims, and claim 21 must be rejoined and examined with elected claim 22.

(4) Consideration of Rejoinder of Non-Elected Species. Applicants request that the Office acknowledge that non-elected species are eligible for rejoinder upon allowance of a generic claim that embraces the elected species. *See* 37 C.F.R. § 1.141(a).

(5) Rejoinder of Group I. Applicants further point out that the claims of Group I are process claims and should be eligible for rejoinder should the claims of Group II be allowed.

Therefore, for at least the above reasons, the restriction should be reconsidered and withdrawn. The election requirement likewise should be reconsidered and withdrawn.

CONCLUSION

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 50-0573 for any such fees; and Applicants hereby petition for any needed extension of time.

Respectfully submitted,
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